



## CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: 14 February 2005 Name: C. Noel Kaman, Reg. No. 51,857 Signature: C. Noel Kaman

BRINKS  
HOFER  
GILSON  
& LIONE

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Botstein et al.

Appln. No.: 09/944,944

Filed: August 31, 2001

For: SECRETED AND TRANSMEMBRANE  
POLYPEPTIDES AND NUCLEIC ACIDS  
ENCODING THE SAME

Examiner: Eileen B. O'Hara

Art Unit: 1646

Attorney Docket No: 10466/137 (P2548P1C18)

Mail Stop Patent Ext.  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

## TRANSMITTAL

Sir:

## Attached is/are:

- ☒ Application for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. Section 1.705(b) with Exhibit A; and a check in the amount of \$200.
- ☒ Return Receipt Postcard

## Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_\_).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

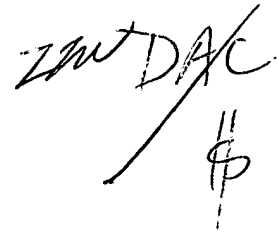
## Fee payment:

- ☒ A check in the amount of \$200 is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

14 February 2005  
Date

C. Noel Kaman  
C. Noel Kaman (Reg. No. 51,857)



**Our Case No. 10466/137  
P2548P1C18**

Group Art Unit No. 1646

(2) A statement of the facts involved:

- (i) A Notice of Allowance and Issue Fee Due was mailed on **January 6, 2005** and included a Determination of Patent Term Adjustment stating that the term of adjustment is **384** days. Correction of the patent term adjustment to add an additional **83** days to the patent term is respectfully requested. Thus, Applicants respectfully submit that the proper total patent term adjustment for this application is **467** days.

The provisions of 37 C.F.R. § 1.702(a)(1)(2) provide the basis for term adjustment of **390** days as set forth in the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

The provisions of 37 C.F.R. § 1.702(b) provide the basis for the additional **83** days of term adjustment requested herein.

- (ii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a), for which an adjustment is awarded in the Notice of Allowance and Issue Fee Due are as follows:

- a) The period of adjustment under 37 C.F.R. § 1.703(a)(1) is the number of days, if any, in the period beginning on the day ("the fourteen month date") after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) of fulfilled the requirements of 35 U.S.C. § 371 (the fourteen-month date) and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.

1. The present application was filed on **August 31, 2001**.  
The fourteen-month date determined pursuant to 37 C.F.R. § 1.703(a)(1) is **October 31, 2002**.
  2. The first notification under either 35 U.S.C. §§ 132 or 151 was not mailed until **September 9, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
  3. Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(1), Applicants are entitled to **313** days of patent term extension.
- b) The period of adjustment under 37 C.F.R. § 1.703(a)(2) is the number of days, if any, in the period beginning on the day ("the four month date") after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.
1. A response to the Non-Final Rejection mailed September 9, 2003 was filed **December 15, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
  2. The four month date for mailing either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151 is **April 15, 2004**.

3. A Final Rejection under 35 U.S.C. § 132 was mailed on **May 17, 2004**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
  4. Based on these events and as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(2), Applicants are entitled to **32** days of patent term extension.
  5. A response to the Final Rejection mailed May 17, 2004 was filed **July 22, 2004**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
  6. The four month date for mailing either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151 is **November 22, 2004**.
  7. Based on these events and as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(2), Applicants are entitled to **45** days of patent term extension.
- c) Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(1)(2), Applicants are entitled to **313** days + **32** days + **45** days = **390** days of patent term extension.

(iii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(b), for which an adjustment is sought are as follows:

a) The period of adjustment under 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day ("the three year date") after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a).

1. The present application was filed on **August 31, 2001**.

The three year date determined pursuant to 37 C.F.R. § 1.703(b) is **August 31, 2004**.

2. The Notice of Allowance and Issue Fee Due was mailed **January 6, 2005**. Please note, since the issue fee is being paid and filed today (February 14, 2005), the patent is scheduled to issue on or before June 14, 2005. Applicants reserve the right to request a further patent term extension, under 37 C.F.R. §§ 1.703(a)(6) and (b), if applicable.

b) Thus, depending on the actual issue date of the patent, under 37 C.F.R. §§ 1.702(b), Applicants should be awarded at least **83** additional days of patent term extension, as requested herein.

(iv) U.S. Patent Application Serial No. 09/945,584 is not subject to any terminal disclaimer.

(v) Circumstances during the prosecution of the application resulting in the patent that constituted a failure to engage in reasonable efforts

to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704(b) include the following:

- a) The Office mailed a First Non-Final Rejection on **September 9, 2003**. Applicants mailed an Amendment and Response on December 9, 2003, which was filed at the Office on **December 15, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced **6 days** based on this transaction.
  - b) Therefore, under the provisions of 37 C.F.R. § 1.704, the adjustment set forth in § 1.703 must be reduced by a total of **6 days**.
- (3) Total patent term adjustment - For the present application, the total patent term adjustment under 37 C.F.R. § 1.703(f) is the period of adjustment under 37 C.F.R. § 1.703 reduced by the reduction under 37 C.F.R. § 1.704. The total adjustment is thus **390 days + 83 days - 6 days = 467 days**, not **384 days** as calculated by the Office.

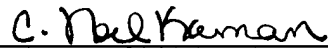
**Patent App. Ser. No.: 09/944,944**

**Date Filed: Aug. 31, 2001**

**Mail Date of Notice of Allowance: January 6, 2005**

Applicants respectfully request reconsideration of the patent term adjustment for this application. Office personnel are invited to contact the undersigned Attorney for Applicants via telephone if such communication would expedite this request.

Respectfully submitted,



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Attorney for Applicants

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<b>Patent Term Adjustment (PTA) for Application Number: 09/944,944</b>			
			<b>Days</b>
Filing or 371(c) Date:	08-31-2001	USPTO Delay (PTO):	390
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	6
Post-Issue Petitions (days):	+0	Total PTA:	384
USPTO Adjustment (days):	+0	<u>Explanation Of Calculations</u>	

### Patent Term Adjustment History

<b>Date</b>	<b>Contents Description</b>	<b>PTO (Days)</b>	<b>APPL (Days)</b>
01-06-2005	Mail Notice of Allowance	45	
01-05-2005	Issue Revision Completed	↑	
01-04-2005	Notice of Allowance Data Verification Completed	↑	
01-04-2005	Notice of Allowability	↑	
10-18-2004	Change in Power of Attorney (May Include Associate POA)	↑	
10-16-2004	Correspondence Address Change	↑	
07-29-2004	Date Forwarded to Examiner	↑	
07-22-2004	Amendment after Final Rejection	↑	
07-22-2004	Workflow incoming amendment IFW	↑	
05-17-2004	Mail Final Rejection (PTOL - 326)	32	
05-14-2004	Final Rejection	↑	
04-22-2004	IFW TSS Processing by Tech Center Complete	↑	
04-22-2004	Date Forwarded to Examiner	↑	
12-15-2003	Response after Non-Final Action	↑	6

09-09-2003	Mail Non-Final Rejection	313	
09-08-2003	Non-Final Rejection	↑	
04-22-2003	Case Docketed to Examiner in GAU	↑	
12-20-2002	Case Docketed to Examiner in GAU	↑	
09-03-2002	Preliminary Amendment	↑	
09-03-2002	Preliminary Amendment	↑	
05-01-2002	Information Disclosure Statement (IDS) Filed	↑	
02-11-2002	Case Docketed to Examiner in GAU	↑	
02-06-2002	Case Docketed to Examiner in GAU	↑	
02-06-2002	Case Docketed to Examiner in GAU	↑	
12-20-2001	CRF Is Good Technically / Entered into Database	↑	
11-28-2001	Case Docketed to Examiner in GAU	↑	
11-09-2001	Application Dispatched from OIPE	↑	
11-07-2001	Correspondence Address Change	↑	
10-26-2001	CRF Is Good Technically / Entered into Database	↑	
09-14-2001	IFW Scan & PACR Auto Security Review	↑	
08-31-2001	Preliminary Amendment	↑	
08-31-2001	CRF Disk Has Been Received by Preexam / Group / PCT	↑	
08-31-2001	Initial Exam Team nn	↑	